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10/564,198	05/01/2007	Peter Isberg	43315-226459	7494

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EXAMINER	
ESTRADA, ANGEL R	
ART UNIT	PAPER NUMBER
2835	
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10/27/2010	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	10/564,198	ISBERG ET AL.	
	Examiner	Art Unit	
	Angel R. Estrada	2835	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *3* MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *13 September 2010*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-17* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1,3,6-11 and 15-17* is/are rejected.

7)☒ Claim(s) *2,4,5 and 12-14* is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date *9/13/10*.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

Information Disclosure Statement

1. The information disclosure statement filed September 13, 2010 has been considered by the Examiner.

Claim Objections

2. Claims 10, 15 and 17 are objected to because of the following informalities:

Claim 10 lines 2-3, "the outer hollow insulator", lacks antecedent basis.

Claim 15 line 2, "the outer hollow insulator", lacks antecedent basis.

Claim 17 lines 2-3, "the outer hollow insulator", lacks antecedent basis.

Appropriate correction is required.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1, 6, 10, 11, 15, and 17 are rejected under 35 U.S.C. 102(b) as being anticipated by Feldmesser (GB 2,058,482; cited in the IDS).

Regarding claim 1, Feldmesser discloses a bushing (see figure 2b) for an electrical device, comprising an insulating core (see figure 2b) comprising an

exterior surface; and a continuous moisture diffusion barrier (column 1 lines 45-column 2 lines 3 line 105) at least partially covering the exterior surface of the insulating core (see figure 2b), the continuous moisture diffusion barrier comprising a continuous film with firm adhesion to the insulating core (see figure 2b).

Regarding claim 6, Feldmesser discloses the bushing (see figure 2b), wherein moisture diffusion barrier (column 1 lines 45-column 2 lines 3 line 105) comprises at least one of the following, an organic film or an organic/inorganic hybrid film (see abstract).

Regarding claim 10, Feldmesser discloses the bushing (see figure 2b), wherein the moisture diffusion barrier (column 1 lines 45-column 2 lines 3 line 105) is deposited on at least part of the insulating core by one of the following methods: dipping, painting, spraying, plasma arc, sol-gel technology, Physical Vapor Deposition or Chemical Vapor Deposition (see figure 2b, column 1 lines 45-column 2 lines 3 line 105).

Note: the method of forming the device is not germane to the issue of patentability of the device itself. Therefore, this limitation "following methods: dipping, painting, spraying, plasma arc, sol-gel technology, Physical Vapor Deposition or Chemical Vapor Deposition" has not been given patentable weight.

Regarding claim 11, Feldmesser discloses a method for manufacturing a bushing (see figure 2b) for an electrical device, the bushing (see figure 2b) comprising an insulating core (see figure 2b) the method comprising: coating at least a part of the insulating core with a continuous moisture diffusion barrier

(column 1 lines 45-column 2 lines 3 line 105) comprising a continuous film with firm adhesion to the insulating core (see figure 2b).

Regarding claim 15, Feldmesser discloses the method (see figure 2b) wherein the insulating core (see figure 2b) is coated with the moisture diffusion barrier (column 3 lines 16-53; epoxy resin) comprising at least one of the followings: an inorganic film, an organic film or an organic/inorganic hybrid film (see figure 2b, column 1 lines 45-column 2 lines 3 line 105; see abstract).

Regarding claim 17, Feldmesser discloses the method (see figure 2b), wherein the moisture diffusion barrier is deposited on at least part of the insulating core (se figure 2b) by one of the following methods: painting, dipping, spraying, plasma arc, sol-gel technology, Physical Vapor Deposition or Chemical Vapor Deposition (see figure 2b, column 1 lines 45-column 2 lines 3 line 105; see abstract).

Note: the method of forming the device is not germane to the issue of patentability of the device itself. Therefore, this limitation "following methods: dipping, painting, spraying, plasma arc, sol-gel technology, Physical Vapor Deposition or Chemical Vapor Deposition" has not been given patentable weight.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims 3, 7-9 and 16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Feldmesser (GB 2,058,482; cited in the IDS).

Regarding claim 3, Feldmesser discloses the claimed invention except for the insulating core comprising a body of epoxy resin impregnated paper. It would have been obvious to one having ordinary skill in the art at the time the invention was made to make the insulating core comprising a body of epoxy resin impregnated paper, since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice. *In re Leshin*, 227 F.2d, 125 USPQ 416 (CCPA 1960).

Regarding claim 7, Feldmesser discloses the claimed invention except for the moisture diffusion barrier comprising a multi-layer film. It would have been obvious to one having ordinary skill in the art at the time the invention was made to make the moisture diffusion barrier comprising a multi-layer film, since it has

been held that mere duplication of the essential working parts of a device involves only routine skill in the art. *In re Harza, 274 F.2d 669, 124 USPQ 378 (CCPA 1960)*.

Regarding claim 8, Feldmesser discloses the claimed invention except for the moisture diffusion barrier comprising particles of hybrid or inorganic nature. It would have been obvious to one having ordinary skill in the art at the time the invention was made to make the moisture diffusion barrier comprising particles of hybrid or inorganic nature, since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice. *In re Leshin*, 227 F.2d, 125 USPQ 416 (CCPA 1960).

Regarding claim 9, Feldmesser discloses the claimed invention except for the moisture diffusion barrier has a coefficient of water permeability smaller than 0.1 $g.m^{-1}.day\text{-}^{1}$. It would have been obvious to one having ordinary skill in the art at the time the invention was made to make the moisture diffusion barrier comprises the moisture diffusion barrier having a coefficient of water permeability smaller than 0.1 $g.m^{-1}.day\text{-}^{1}$, since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice. *In re Leshin*, 227 F.2d, 125 USPQ 416 (CCPA 1960).

Regarding claim 16, Feldmesser discloses the claimed invention except for the insulating core being coated with a moisture diffusion barrier comprises a multi-layer film. It would have been obvious to one having ordinary skill in the art

at the time the invention was made to coat the insulating core with a moisture diffusion barrier comprising a multi-layer film, since it has been held that mere duplication of the essential working parts of a device involves only routine skill in the art. *In re Harza, 274 F.2d 669, 124 USPQ 378 (CCPA 1960).*

Allowable Subject Matter

5. Claims 2, 4, 5 and 12-14 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

The following is an examiner's statement of reasons for allowance: The primary reasons for the indication of the allowability of claims 2, 4, 5 and 12-14 are:

Regarding claim 2, the prior art does not teach or fairly suggest in combination with the other claimed limitations a bushing for an electrical device, comprising an insulating core is hollow and that at least part of the inside of the insulating core is coated with the moisture diffusion barrier.

Regarding claims 4 and 5, the prior art does not teach or fairly suggest in combination with the other claimed limitations a bushing, further comprising: an outer hollow insulator arranged outside the insulating core and wherein at least a part of the outer hollow insulator is coated with the moisture diffusion barrier.

Regarding claim 12, the prior art does not teach or fairly suggest in combination with the other claimed limitations a method, wherein the insulating

core is hollow, and wherein at least part of the inside of the insulating core is coated with the moisture diffusion barrier.

Regarding claims 13 and 14, the prior art does not teach or fairly suggest in combination with the other claimed limitations a method, further comprising: arranging an outer hollow insulator outside the insulating core and coating at least a part of the outer hollow insulator with the diffusion barrier.

These limitations found in claims 2, 4, 5 and 12-14, and are neither disclosed nor taught by the prior art of record, alone or in combination.

Conclusion

6. Any inquiry concerning this communication should be directed to Angel R. Estrada at telephone number (571) 272-1973. The Examiner can normally be reached on Monday-Friday (8:30 -5:00).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jinhee J. Lee can be reached on (571) 272-1977. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR

system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) OR 571-272-1000.

October 24, 2010

/Angel R. Estrada/
Primary Examiner, Art Unit 2831